

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

AME00130P00250US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 10-18-07

Signature Terri Craine

Typed or printed name Terri Craine

Application Number

10/721,135

Filed

11/25/03

First Named Inventor

Robert Kronenberger

Art Unit

3765

Examiner

A. Sutton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 30,407
Registration number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

John S. Mortimer
Signature

John S. Mortimer

Typed or printed name

312-876-1800

Telephone number

Oct 18, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:) HEADWEAR PIECE WITH
) SELECTIVELY VIEWABLE
ROBERT KRONENBERGER) ORNAMENTATION
)
Ser. No.: 10/721,135) Group Art Unit: 3765
)
Filed: 11/25/03) Examiner: Andrew W. Sutton

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

This is a request for a review of the rejection made in the August 21, 2007 Final Office Action in the above case. A review is requested with respect to the errors specifically identified below.

Background

The claimed subject matter is a headwear piece 10 with a crown 12 (Fig. 2) for embracing a wearer's head, thereby to maintain the headwear piece in an operative position thereon. For purposes of designating locations on the crown, the crown in the sole independent claim, claim 1, is divided into eight "octants" 38, 40, 42, 44, 46, 48, 50, 52

37 CFR 1.8
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 10-18-07 (date).


Terri Craine

(Fig. 5). A brim/bill 32 projects forwardly from the crown 12 to define a conventional baseball-style cap construction.

The crux of the invention is the strategic placement of specifically identified different information at specific locations described with reference to the octants. As seen in Fig. 2, first information, identifying an event, is provided on at least one of the front/left side and front/right side octants 46, 38 (Fig. 5) so as to be at the front of the headwear piece 10 and plainly viewable from an elevated front perspective view thereof. As seen in Fig. 5, second information 56 (Fig. 2), identifying a plurality of participants in the event (the event as identified by the first information), is provided on at least one of: a) the right side/front octant 40; b) the right side/rear octant 42; c) the rear/right side octant 44; d) the left side/front octant 48; e) the left side/rear octant 50; and f) the rear/left side octant 52.

The significance of this construction can be understood with the headwear piece used at an exemplary all star event, with the first information relating to the all star game and the second information relating to the teams in the league that are participants in the game. The headwear piece can be worn by players in conventional manner during the game. The first information will be plainly visible from a front view to satisfy the identity needs for promoters of the all star game, in the same manner as team logos and identities are visible when placed at the same location with conventional team caps.

The second information, by reason of its location, rearwardly and to the side of the first information, is not plainly visible, and does not lessen the prominence of the first information, from a front perspective from which most players will be viewed before, during, and after a competition.

Thus, the headwear piece can be used by players to function as a traditional headwear piece. The second information appeals to souvenir collectors and fans that can purchase and view the entirety of the headwear piece from different perspectives to be reminded of the participants in the game, thereby having an informative memento identical to what was worn by the players during the game.

The Rejection of Claims

Claims 1-3 and 5-21 are currently pending and at issue. Claims 1-3, 5-9 and 11-18 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 6,175,963 (Loeffelholz) in view of U.S. Patent No. 6,370,696 (Kronenberger). Claims 19-21 stand rejected under 35 U.S.C. §103 as obvious over Loeffelholz in view of Kronenberger, and further in view of U.S. Patent No. 5,584,076 (Armstrong).

Pending Claims

Claim 1 is the only independent claim and will be focused on herein.

Error No. 1

The Examiner improperly treats the information and its location as without any patentable significance and incorrectly concludes that the information claimed "provides no new function". (Final Action page 2, lines 14-16).

Argument

The Federal Circuit in *In re Gulack* 217 USPQ 401 (Fed. Cir. 1983) stated that "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter" (at page 403). In this case, it is the content and location of the information that together have patentable significance. The claimed strategic placement of specific types of information results in a versatile headwear piece, as described above and on page 3 of Applicant's June 6, 2007 Response, that is not disclosed in, or obvious from, the cited art.

Error No. 2

In attempting to reconcile a conclusion that the strategic placement of information claimed by the applicant is a mere design choice with the finding by the Court in *In re Miller* (418 F.2d 392), the Examiner argues that the application of indicia on a measuring cup in

Miller modifies the measuring cup differently than the information modifies Applicant's headwear piece.

Argument

The indicia in *In re Miller* identify fractional recipe amounts versus whole recipe amounts. Whereas, the Examiner argues on page 2 of the Final Action that the claimed cap "still functions as a cap as it does without that information", the *Miller* measuring cup functions likewise identically regardless of the nature or existence of indicia thereon. There is no distinction between the cup and Applicant's cap in this regard. In *Miller*, what is significant is the mental perception of a user that he/she is preparing a full recipe when in fact only a part of a recipe is being prepared.

Similarly, the functional significance of Applicant's claimed structure relates to mental perception based upon what is viewed. In the front of the headwear piece, seeing plainly only the first information, the perception is that the headwear piece is a functioning baseball cap as would be worn by a player. From other perspectives, the second information, relating to participants, that is not plainly viewable from the front, can be seen to allow the headwear piece to function informationally in a different manner as a souvenir on which event participants are identified.

Error No. 3

Claim 1 is not obvious over Loeffelholz in view of Kronenberger

Argument

The Examiner concludes on page 3 of the Action that the information claimed "provides no structure to the cap that is not shown in the prior art". The Examiner acknowledges that neither Loeffelholz nor Kronenberger "shows" the specific nature and location of information claimed by Applicant. The Examiner admits in the March 6, 2007

Action that "the information of Loeffelholz and Kronenberger are not the same as claimed by the Applicant" (at pg. 2). While concluding that it would have been obvious to place the information as claimed, the Examiner articulates no reason why one skilled in the art would have been motivated to modify Loeffelholz in view of Kronenberger to place the specific first and second information at the strategic locations required in claim 1. By ignoring the significance of the information, as mandated by the Federal Circuit in *In re Gulack*, the Examiner has improperly avoided the need to present, and thus has not presented, evidence to establish even a *prima facie* case of obviousness.

Conclusion

It is respectfully requested that the panel review the Examiner's August 21, 2007 Final Rejection, particularly based upon the errors noted above, and that the Examiner's rejection of all pending claims be reversed.

Respectfully submitted,

By 
John S. Mortimer, Reg. No. 30,407

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER
500 W. Madison St., Suite 3800
Chicago, IL 60661
(312) 876-1800

Date: Oct 18, 2007